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10/722,268	11/25/2003	Christiaan Steenberg	DC-05754	6368
33438 7590 06/25/2009 HAMILTON & TERRILE, LLP P.O. BOX 203518 AUSTIN, TX 78720			EXAMINER GIESY, ADAM	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CHRISTIAAN STEENBERGEN, ED BEEMAN,  
DIRK ERICKSON, THOMAS L. PRATT, and  
CHARLES ROBERT WEIRAUCH

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Appeal 2009-002594  
Application 10/722,268  
Technology Center 2600

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Decided:<sup>1</sup> June 23, 2009

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Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT,  
and CARLA M. KRIVAK, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1-20, which constitute all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

#### STATEMENT OF THE CASE

Appellants' invention relates to information storage in optical media wherein embedded information generally must be readable when the medium is inserted into an optical drive (Spec. 2). Storing information includes embedding separate sets of aligned information on an optical medium that are each readable by an optical drive at start up of an optical drive read (Spec. 3). Claim 1, which is illustrative of the invention, reads as follows:

1. An optical medium disc for storing information readable by an optical disc drive, the optical medium disc comprising:

a first layer having reflective properties, the first layer operable to store information through manipulation of the reflective properties by a laser;

a second layer disposed over the first layer;

a first set of embedded information stored at the first layer within a first range of radii of the optical medium; and

a second set of embedded information stored at the second layer aligned to substantially overlap the first set of information.

The Examiner relies on the following prior art in rejecting the claims:

Gotoh

US 6,278,671 B1

Aug. 21, 2001

Claims 1, 2, 5-12, and 16-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gotoh.

Claims 3, 4, and 13-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gotoh.

Rather than repeat the arguments here, we make reference to the Briefs and the Answer for the respective positions of Appellants and the Examiner.

### ISSUE

Appellants' arguments are focused on the anticipation rejection of independent claims 1, 11, and 17 and state that Gotoh writes the barcode and the other information on the same layer, or in case of a two-recording-layer disk, writes the barcode and the pit data on both layers (App. Br. 3-4). Therefore, the issue specifically turns on whether Gotoh anticipates Appellants' claimed invention by disclosing first and second sets of embedded information stored in different layers overlapping each other.

### FINDINGS OF FACT

The following findings of fact (FF) are relevant to the issue involved in the appeal.

1. Gotoh provides for converting data, such as a disk ID number, into a barcode and recording the data in a pit area in overwriting fashion, thereby permitting the use of a single optical pickup to read both the bit data and barcode data. (Col. 1, ll. 46-51.)

2. Gotoh discloses in Figure 7 the signal waveforms for a two-recording-layer disk (col. 11, ll. 59-63), wherein the waveform from the second layer is similar to that from the first layer (col. 11, ll. 65-67).

3. As shown in FIG. 2, the barcode (stripes) 584c-584e are written over the prescribed region (stripe area) of the pre-pit area; therefore, the tracking is disturbed in that prescribed region. (Col. 41, ll. 11-14).

4. To avoid this problem, as shown in FIG. 39, Gotoh suggests forming the marking 941 in a pit area 941a at a radius position different from the radius position of the stripe area 923a, such that only a few tracks are destroyed by forming a pinhole marking. (Col. 41, ll. 18-28.)

5. Alternatively, the marking 941 may be recorded in the guard-band area 999 shown in Figure 30, such that destroying already recorded data by recording the marking 941 may be avoided since the guard-band area 999 contains no data, but address information. (Col. 41, ll. 29-33.)

6. Since an ID unique to each individual disk is converted into a barcode and written in overwriting fashion to an ordinary pit area, both the pit data and barcode data can be read by using the same optical pickup. (Col. 41, ll. 53-59.)

## PRINCIPLES OF LAW

A rejection for anticipation requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. *See Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

### ANALYSIS

With respect to claim 1, Appellants argue that Gotoh embeds a barcode in the optical medium by writing the barcode information over the stored pit data (App. Br. 3). Appellants further assert that, even in the two-recording-layer disk of Figure 7 embodiment, the barcode is written on both layers destroying the already stored information (*id.*). The Examiner refers to the description of Figures 2A-2E in column 41 and responds that the writing of the barcode only destroys the reflectivity of the layer, and not the data stored therein (Ans. 3-4).

We agree with Appellants and find that Gotoh repeatedly refers to destroying the stored information when the barcode data is recorded in overwriting fashion (FF 1) and even suggests ways to avoid destroying the necessary information by overwriting (FF 4-6). We also disagree with the Examiner's assertion (Ans. 3) that the writing of the barcode information in the embodiment of Figure 7 only destroys the reflectivity of the layer and therefore, meets the subject matter recited in claim 1. Gotoh makes it clear that the same information is written in both layers since the waveform for writing to each layer is the same (FF 2). Also when the barcode information is written in both layers, Gotoh discloses that such information is recorded in overwriting fashion over the pit area (FF 1).

As such, we agree with Appellants (Reply Br. 1) that, since Gotoh uses the same layer for both types of information, or writes the same barcode information over already stored information in each layer, there is no first and second set of embedded information at the first and second layers. We also agree with Appellants' arguments regarding claims 11 and 17 (App. Br. 3-4; Reply Br. 1-2) that since Gotoh embeds the two sets of information (the

barcode and the pit data) in the same layer (FF 3-6), Gotoh does not anticipate these claims.

### CONCLUSION

On the record before us, we find that the Examiner fails to make a prima facie case that Gotoh anticipates claim 1 or the other independent claims 11 and 17 which include similar limitations. Therefore, in view of our analysis above, the 35 U.S.C. § 102 rejection of claims 1, 2, 5-12, and 16-20 as anticipated by Gotoh cannot be sustained. Additionally, we do not sustain the 35 U.S.C. § 103 rejection of claims 3, 4, and 13-15 over Gotoh since the Examiner has not identified any modification to the reference to overcome the deficiencies discussed above.

### ORDER

The decision of the Examiner rejecting claims 1-20 is reversed.

Appeal 2009-002594  
Application 10/722,268

REVERSED

ELD

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